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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/863,692	05/27/97	JEANNIN	P XI/P3141US1

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EXAMINER

CLARDY, S

ART UNIT

PAPER NUMBER

1616

12

DATE MAILED:

08/24/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/863,692

Applicant(s)
Jeannin

Examiner
S. Mark Clardy

Group Art Unit
1616



☒ Responsive to communication(s) filed on Jun 5, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-59 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-59 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-59 are pending in this application which is a continuation-in-part of SN 08/692,113, filed August 5, 1996.

Applicant's claims are drawn to compositions in a fluid formulation for skin application, and methods of using them for control of fleas on small mammals (e.g., cats and dogs) comprising:

- A) a 1-phenylpyrazole or 1-(2-pyridyl)pyrazole derivative, and
- B) an ovicidal insect growth regulator (IGR), e.g., juvenile hormones or chitin synthesis inhibitors (see claim 6).

Exemplified compositions comprise:

- A) fipronil
- B) pyriproxyfen or methoprene (both juvenile hormone type IGRs).

The provisional double patenting rejection of claims 1-48 is withdrawn in response to the abandonment of SN 08/692,113. The rejection of claim 27 under 35 USC 101 and the rejection of several claims under 35 U.S.C. 112, second paragraph, is withdrawn in response to Amendment B.

Claims 8, 9, and 31, have not been amended, but retain the same hybrid shorthand notation for chemical compounds noted previously. Again, chemical structures or the complete chemical names for the compounds are preferred for the sake of future searching (should other junior applicants claim the same material as that disclosed herein.) Applicants are expected to possess the requisite skill in the art to be able to provide correct structures and/or names.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-48 are again rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Duffy et al (US 5,612,047), Postal et al¹, and Skillman et al (PCT WO 95/33380), for reasons of record, as well as the following.

Duffy et al, again, teach microemulsion formulations for the control of ticks and fleas comprising IGRs including juvenile hormones, juvenoids and chitin synthesis inhibitors (e.g., methoprene, col 2, lines 32-37), in addition to active agents such as pyriproxyfen (line 53). The compositions may be used as "dips, sprays, pour-ons, spot-ons, conditioning creams, aerosol mouses," etc. (col 5, lines 20-27).

Postal et al teach that fipronil was a known insecticidal agent for use in controlling fleas in dogs and cats, in a spray formulation for skin application.

Skillman et al is cited merely to show that each of the active agents recited herein was known in the art.

One of ordinary skill in the art would be motivated to combine these references because they disclose active agents for use in controlling the same pests on the same hosts.

Thus, again, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicant's active agents because they were known

¹Postal et al. "Field Efficacy of a Mechanical Pump Spray Formulation Containing 0.25% Fipronil in the Treatment and Control of Flea Infestation and Associated Dermatological Signs in Dogs and Cats". *Veterinary Dermatology*. 6(3):153-158. 1995.

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flea controlling agents by application to the skin of infested animals. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069. It is immaterial whether the mechanism of control of one agent is different from that of another with which it is combined for the same purpose.


Again, no comparisons with the closest prior art have been presented; nor are there any comparisons of the A + B composition vs A alone and B alone. No unobvious or unexpected results are noted.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.


S. Mark Clardy
Primary Examiner
AU 1616

August 21, 1998